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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,739	08/07/2001	Shigehiro Miyashita	Q65752	9599

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SUGHRUE, MION, ZINN
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EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,739	MIYASHITA, SHIGEHIRO	
	Examiner	Art Unit	
	Md S Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 10/13/04. Claims 1-15 and 23-27 are pending. Claims 16-22 and 28 have been cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 1-15 and 23-27 been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Objections

3. Claim 11 is objected to because of the following informalities: the phrase 'to and' in page 7, line 4 of the claim appears to be 'to'. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 8-15 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Alanara (U.S. Patent No. 6,064,880).

Regarding claim 1, Alanara teaches a mobile station 10 [i.e., mobile phone] (fig.2).

Alanara further teaches a BMI [i.e., directory server] remote from the mobile station (fig.2).

Alanara further teaches a storage unit which stores SCM backup data [i.e., a directory of records], each data (i.e., record) comprising data of a telephone number, a name and an address (i.e., contact) (abstract; fig.2, 3A; col.5, lines 1-19, 30-32).

Alanara further teaches a communication control unit which refers to the directory to determine whether or not a requested connection of a contact to the mobile phone is permitted, and which transmits a response indicative of authorized or not authorized [i.e., permission or non-permission] of the connection (abstract; col.4, line 49-col.5, line 19, lines 30-32).

Regarding claim 2, Alanara teaches a storage unit which stores the directory of records, each record contains at least a name, a phone number or an e-mail address of a contact, such that the directory of records stored in the directory server is a replica of the directory of records stored in the mobile phone (abstract; col.4, line 49-col.5, line 19, lines 30-32).

Alanara further teaches an operation section which generates an upload instruction in response to an operation by a user of the mobile phone (col.4, line 49-col.5, line 19, lines 30-32).

Alanara further teaches a transmitting section, which transmits the directory of records from the mobile phone to the directory server in response to the upload instruction such that the directory of records of the mobile phone is stored in the directory server as a replica directory of records (abstract; fig.3A; col.4, line 49-col.5, line 19, lines 30-32, 47-67, col.6, line 1).

Regarding claims 3, 9 and 13, Alanara teaches that the group of records of the directory data of the mobile phone includes edit flag (col.5, lines 1-19).

Alanara teaches the mobile phone further comprises a keypad [i.e., editing section] which edits the group of records including the edit flag in response to an operation by the user (fig.1; col.5, lines 1-19).

Alanara further teaches that a transmitting section of the mobile phone transmits the records of the group including the edit flag to the directory server in response to upload instruction such that the group of records including the edit flag is stored as part of the replica directory of records in the directory server (col.4, line 49-col.5, line 19, lines 30-32).

Regarding claims 4, 10 and 14, Alanara teaches that the number of records in each group is inherently one (abstract; col.5, lines 1-19).

Regarding claims 5 and 15 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claims 8 and 12 are rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claim 5. Furthermore, Alanara teaches that the operation section generates a download instruction in response to an operation by the user and the transmitting section transmits the download instruction to the directory server in the communication control network (abstract; col.4, line 49-col.5, line 19, lines 30-32, 47-67, col.6, line 1).

Regarding claim 27 is rejected for the same reasons as discussed above with respect to claims 1 and 3.

6. Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cox et al. (U.S. Patent No. 6,256,515).

Regarding claim 23, Cox teaches in response to a communication request from a contact, referring to a directory of records, each record comprising data of a contact, to determine whether or not a connection with the contact is approved (i.e., permitted) (abstract; col.3, lines 5-37, col.4, lines 42-62, col.7, lines 16-25).

Cox further teaches connecting a communication from the contact if the connection is approved (i.e., permitted), and discarding the communication from the contact if the connection is not approved (abstract; col.3, lines 5-37, col.4, lines 42-62).

Regarding claim 24, Cox teaches that each record comprises a phone number (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 25, Cox teaches that communication request is a phone call from a contact (abstract; col.3, lines 5-37, col.4, lines 42-49).

Regarding claim 26, Cox teaches that the communication request is an e-mail address from a contact (col.9, lines 21-26).

7. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Weinman, Jr. (U.S. Patent No. 6,658,455).

Regarding claim 27, Weinman teaches inputting at least one record into a memory (i.e., storage unit) in a cellular telephone (i.e., mobile phone) (col.4, lines 30-49, col.5, lines 33-35, col.8, lines 19-37, col.9, lines 32-50, col.13, lines 60-65).

Weinman further teaches transmitting, via an antenna in the mobile phone, the records stored in the memory of the cellular phone to a single personal directory list (PDL) (i.e., directory server) in a communication control network (col.9, lines 32-50). (Note: antenna is inherent)

Weinman further teaches updating the records to the single personal directory list (PDL) (i.e., telephone directory server) thereby creating a subset (i.e., replica directory or records) (col.4, lines 30-49, col.9, lines 32-50).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent No. 6,064,880) in view of Cox et al. (U.S. Patent No. 6,256,515).

Regarding claim 6 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Alanara teaches the requested communication is a phone call (col.3, lines 26-28) and each record, stored in the directory of records of the directory server, comprises a phone number of a contact (col.5, lines 1-19).

and a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected (page 12, lines 1-19).

Alanara does not specifically teach a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected. Cox teaches a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is

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reset when a phone call from the corresponding contact should be connected (abstract; fig.3; col.3, lines 5-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara to incorporate a non-permission flag, which is set when a phone call from the corresponding contact should not be connected and which is reset when a phone call from the corresponding contact should be connected as taught by Cox. The motivation for the modification is to have doing so in order to manage unofficial calls.

Alanara does not specifically teach a switching apparatus which connects a phone call from a contact when a permission response is received from said communication control unit, and which discards a phone call from a contact when a non-permission response is received from said communication control unit. Cox teaches a switching apparatus which connects a phone call from a contact when a permission response is received from the communication control unit, and which inherently discards a phone call from a contact when a non-permission response is received from the communication control unit (abstract; fig.3; col.3, lines 5-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara to incorporate a switching apparatus which connects a phone call from a contact when a permission response is received from the communication control unit, and which discards a phone call from a contact when a non-permission response is received from the communication control unit as taught by Cox. The motivation for the modification is to have doing so in order to manage unapproved calls. (Note; if caller's entered personal code does not match it is inherent that the caller will not get connection with the called party)

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10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent No. 6,064,880) in view of Cox et al. (U.S. Patent No. 6,256,515) further in view of Fernandez et al. (International Pub. No. WO 99/65256).

Regarding claim 7 is rejected for the same reasons as discussed above with respect to claim 6. Furthermore, Alanara in view of Cox fails to teach that a mail server delivers an e-mail from a contact. Fernandez teaches that an e-mail forwarding system (i.e., mail server) delivers the e-mail from a contact (abstract; page 5, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alanara in view of Cox to allow a mail server delivering the e-mail from a contact as taught by Fernandez. The motivation for the modification is to have doing so in order to answer the inbound call as well as make outbound call to the user.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pepe et al. (U.S. Patent No. 5,742,668) teach Electronic massaging network.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

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April 17, 2005



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